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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,788	12/11/2000	Masayuki Kondo	Q62242	2735

7590 03/19/2003

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER
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NGUYEN, THUKHANH T

ART UNIT	PAPER NUMBER
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1722

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DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/732,788

Applicant(s)

KONDO, MASAYUKI

Examiner

Thu Khanh T. Nguyen

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. In order to avoid abandonment, the drawing informalities noted in Paper No. 5, mailed on April 02, 2002, must now be corrected. Correction can only be effected in the manner set forth in the above noted paper. The Applicant has indicated in the last Amendment that the corrected Figures 4A and 4B have been submitted, however, the copy of the drawings are not found. Please resent those drawings.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipate by Richardson (4,204,896).

Richardson teaches an apparatus for forming joints between cables or electrical conductors, comprising an upper mold (9 & 16) having an inner space with a dome-shaped ceiling face (Fig. 3, 7), which defines an upper part of a molding cavity, a lower mold (3) having an inner space provided with vertical side faces (6) and a bottom face (5) which defines a lower part of the molding cavity; wherein the dome-shaped ceiling face of the upper mold has a curvature (7) for forming a curvature of an outer face of the joint.

Art Unit: 1722

4. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Birchler et al (4,043,027).

Birchler et al teach an apparatus and method for forming terminal connecting portion of conductor wires (Figs. 8a-c), comprising an upper mold (62) with a dome-shaped ceiling face (66) having a curvature to form a corresponding curve on the product (110), and a lower mold (60) having vertical side faces (both side of the cavity 64) and a bottom face (65) which defines a lower part of the molding cavity.

5. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Saito (5,620,711).

Saito teaches a mold for forming a waterproof cable, comprising an upper mold (col. 3, lines 8-9) having an inner space provided with dome-like ceiling face (9), which defines an upper part of a molding cavity (7), a lower mold (1) having inner space provided with vertical side faces (both sides 15, 17 along the cavity 7) and a bottom face (7a, the bottom of the cavity 7); wherein the dome-like ceiling face of the upper mold has a curvature so selected as to be coincident with a curvature of on outer face of terminal fitting (39, col. 4, lines 4-10).

6. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis et al (*Applied Plastic Product Design*, Prentice-Hall 1946, page 74).

Davis et al teach a mold comprising an upper and lower mold halves (Fig. 4-29); wherein the upper mold half having a dome-shape face corresponding with the forming product, and the lower mold half having vertical side faces and a flat bottom defining a lower part of the cavity.

***Response to Amendment***

7. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-2 have been considered but are moot in view of the new ground(s) of rejection.

Richardson and Birchler et al disclose an apparatus for forming joints between electrical conductors and the cables. In which the apparatus comprises an upper and lower mold with a bottom surface, and vertical side surfaces on the lower mold. Birchler et al further includes a flat bottom surface. Davis et al disclose a mold having dome-shaped upper surface, and a lower mold having vertical side walls and a flat bottom surface.

Saito discloses a molding apparatus including all the limitations at required by the claims for injecting a packing material among wires of an electric wire bundle to inhibit water. The apparatus comprises an upper and lower mold half with a dome shaped cavities; each of the mold half includes 2 vertical side portions along the wire, and a concave bottom face which defines a lower part of the molding cavity.

The Applicant alleged that Saito is intended to surround a plurality of wires which a waterproof material, which is different that the prior art, and the current invention, that is intended to encapsulate a metal connector with a waterproof material. However, this is the intended use of the apparatus and would not render the patentability of the apparatus claims. It has been held that a functional limitation asserted to be critical for establishing novelty may, in

Art Unit: 1722

fact, be an inherent characteristic of the prior art. The applicants is required to prove that the subject matter shown in the prior art does not necessarily possess the characteristics relied on. In re Schreiber, 128 F. 3d 1473, 1478, 44 USPQ 2d, 1432 (Fed. Cir. 1997); See also, In re Spada, 911 F 2d 705, 708, 15 USPQ 2d 1655, 1658 (Fed. Cir. 1977); In re Best, 562 F. 2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); and Ex Parte Gray, 10 USPQ 2d 1922, 1925 (Bd. Pat. App. & Int. 1989).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Khanh T. Nguyen whose telephone number is 703-305-7167. The examiner can normally be reached on Monday- Friday, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

TN  
March 17, 2003

  
ROBERT DAVIS  
PRIMARY EXAMINER  
GROUP 1300-1722

3/17/3